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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/990,981	12/15/97	MURAKOSHI S	P7156-7043

EXAMINER	
HINDI, N	
ART UNIT	PAPER NUMBER
2651	20

TM02/0129
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DATE MAILED: 01/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/990,981	Applicant(s) MURAKOSHI ET AL
	Examiner NABIL HINDI	Group Art Unit 2651

☒ Responsive to communication(s) filed on *Dec 15, 2000* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *15-56* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *15-26* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *27-56* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

In response to applicant's amendment dated Dec. 15, 2000. The following action is taken:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 15-26 are, drawn to reading an address from a disk to access information using the Internet, classified in class 709, subclass 217.

II. Claims 27-56 are, drawn to reading information from a medium in connection to a detector to access a local or remote system, classified in class 369, subclass 58.

The inventions are distinct, each from the other because:

Inventions group one and group two are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention group two has separate utility such as an optical disk recording and reproducing apparatus which does not require an address reading to access the Internet. See MEP. § 806.05(d).

Newly submitted claims 27-56are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims do not require an address reading in order to access the Internet

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-56 are withdrawn from consideration as being directed to a non-elected invention. See 37 CAR 1.142(b) and MEP. § 821.03.

Claims 15-26 are rejected for the same reasons set forth in the previous office action mailed June 16, 2000 repeated herein for applicant's convenience.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15-26 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Inai (6055565); Hosoe (6047376); Ozaki et al (5991798); or Dunworth et al (5930474).

The claims are broadly cited and interpreted by the examiner as recording an active link (URL, web address, HTML...etc) into a disk, reading the web link from the page to be connected to the Internet, then reading information corresponding to the disk and displaying such information on a screen. Each of the references discloses the use of a disk having a web address recorded therein.

When the address information is read, the device is connected to the corresponding server and data corresponding to the disk is displayed as shown in figs 9-20 of Dunworth et al; figs 1,2 and 7 of Ozaki et al; figs 1 and 2 of Hosoe; and fig 12 of Inai.

Applicant's arguments filed Dec. 15, 2000 have been fully considered but they are not persuasive. Applicant's arguments are centered around the prior art can not be used as references since the filing date of the references are filed after the priority date of the application. However, applicant can only overcome the rejection if only an English translation copy of the priority documents are filed. In response to applicant's arguments drawn to the reference (5930474), applicant's attention is drawn to column 8 lines 1-21. The URL's are recorded on a disk in order to access information over the net meeting applicant's claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's attention is drawn to 6101534 having a medium with address information to access the Internet.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to NABIL.HINDI at telephone number (703) 308.1555

NABIL HINDI
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